

DETAILED ACTION

This action is in response to the amendment received on November 19, 2008. The Examiner acknowledges that the amendment was filed with a request for continued examination. The Examiner also acknowledges that claims 72-74, 77-80, 84, 87-95, 103, & 106-114 were amended, claims 1-4, 6, 7, 12-15, 18-28, 32, 35-48, 51-54, 57-69, 102, 128-130, 133-147, 150-158, & 220-227 were canceled, and claims 228-241 were newly added. Therefore, claims 72-74, 77-80, 84, 87-95, 97, 103, 106-114, & 228-241 are currently pending. However, claims amended and newly added (i.e. the pending claims) appear to be directed to a distinct invention, not previously examined, thus, the Applicant is directed to an election by original presentation below.

Election/Restrictions

Restriction to one of the following inventions is required:

- I. Previous claims as presented February 29, 2008, including claims 1-4, 6, 7, 12-15, 18-28, 32, 35-48, 51-54, 57-69, 72-75, 77-80, 84, 87-95, 97, 102, 103, 106-114, 128-130, 133-147, 150-158, & 220-227, drawn to an animated character that is superimposed over a game screen, where the character is periodically triggered to communicate information to the player, the character communicating such information as the awarding of prizes or appearance of dispensing a prize, classified in class 463, subclass 31.
- II. Amended claims or new claims as presented November 19, 2008, including claims 72-74, 77-80, 84, 87-95, 97, 103, 106-114, & 228-241, drawn to a gaming machine which generates a character based on a triggering event, the character associated with a first and second game, further where the first and second game appear to be bonus or secondary games in addition to a primary or base game, classified in class 463, subclass 20.

Group II is directed to an invention that is independent or distinct from Group I or the original originally claimed and examined in the instant application for at least the following reasons: Group II is directed to a character associated with secondary games, such as different first and second games, which appears to be a distinct invention from Group I, which is directed to an animated character superimposed on a game that appears periodically to communicate information to the game player, such as the awarding of bonus prizes or the like. While, both inventions include the concept of a "character", nonetheless, both inventions use of the character is mutually exclusive and distinct in terms of patentability. The invention of Group II, in any independent or dependent claims does not appear to recite the features of Group I, such as an animated character superimposed on the game screen of a base game for communicating information. Further, the dependent limitations of Group II appear to further limit the first and second game and how the character may perform certain actions in these games, where as the direction of Group I included the animated character performing certain actions in a base game, including communication of various information. Lastly, to those skilled in the art new claim 228 of Group II is clearly a distinct invention in view of Claim 1 of Group I. Therefore, Group I and Group II are related as subcombinations useable together in a single combination. The subcombinations are distinct if they do not overlap in scope and not obvious variants, and if it shown that the at least one subcombination is separately useable. In the instant application the animated character of Group I may be used separately without any association to a "first and second game" as presented in Group II.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims of Group II are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The amendment filed on November 19, 2008 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03).

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MBS/

/Corbett Coburn/
Primary Examiner
AU 3714